

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YASUSHI NISHIMURA

Appeal No. 2004-2330
Application No. 09/986,977

HEARD: MARCH 9, 2005

Before MCQUADE, NASE and BAHR, Administrative Patent Judges.

BAHR, Administrative Patent Judge.

DECISION ON APPEAL

Appellant originally appealed the examiner's rejection of claims 15-20. On page 2 of the answer (Paper No. 18), the examiner withdrew the rejection of claim 20, which appellant subsequently amended to place it in independent form (see Paper Nos. 19 and 22). Accordingly, claim 20 now stands allowed and this appeal involves only claims 15-19. No other claims are pending.

We REVERSE.

BACKGROUND

The appellant's invention relates to a fishing reel having a reel body coated on an obverse-layer side with a ground film-layer formed by a paint coat and a metal film providing a mirroring effect formed semi-transparently on an obverse-layer side of the ground film-layer. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The examiner relied upon the following prior art references of record in rejecting the appealed claims:

Manabe et al. (Manabe)	4,369,225	Jan. 18, 1983
Mamoru (Japanese patent document)	11-206284	Aug. 3, 1999
Kazuya (Japanese patent document)	2001-17040	Jan. 23, 2001 ¹

The following rejections are before us for review.

Claims 15 and 17-19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kazuya in view of Manabe.

Claims 15 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mamoru in view of Manabe.

¹ We derive our understanding of the Mamoru and Kazuya references from the computer translations obtained by the USPTO, copies of which are appended hereto. While these translations are ostensibly imprecise and incomplete, we note that they constitute the evidence presented to this panel by the primary examiner and thus decide this appeal on the basis thereof.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 18) for the examiner's complete reasoning in support of the rejections and to the brief and reply brief (Paper Nos. 17 and 20) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

In our view, a dispositive issue in this appeal is the limitation in claim 15, the only independent claim before us, "said metal film means being formed **semitransparently** on an obverse-layer side of said ground film-layer" (emphasis ours). Appellant's specification explains the importance of this limitation as follows:

In this paint-coated component, a ground film-layer is formed from paint on a component body made of a synthetic resin or a magnesium alloy. On the upper layer, a semitransparent metal film layer is formed by a metal-vapor deposition, by adjusting a metal having a semitransparent mirroring effect with a half-transparency. Herein, to "adjust the metal with a half-transparency" means to vary the proportion of the ground film-layer that is masked, by adjusting the thickness of the metal film layer. In this case, adjusting the proportion as one of 50%, 25%, 15% and 5% – i.e., making the ground film-layer masking rate to be one of the aforementioned proportions – is preferable, since the

light can pass through the metal film layer, and the ground film-layer can be visually recognized. Herein, in a certain position, the light is reflected on the ground coating, showing the tone of the paint, while in another position the light is reflected on the metal film layer due to the half-mirroring effect, showing a metallic mirrored surface with the hue of the ground coating. In this manner, the ground coating yields iridescent patterns, and the metal film layer yields a metallic mirrored surface, improving the appearance of the design [specification, page 1 and 2].

The examiner appears to concede on pages 3 and 5 of the answer that neither of the primary references, Kazuya and Mamoru, relied upon by the examiner in rejecting the claims teaches or suggests a ground film-layer formed by a paint coat and a metal film layer providing a mirroring effect and being formed semi-transparently² as a layer on the ground film-layer side. The examiner's conclusion of obviousness is grounded on the position that Manabe teaches such a ground film layer/metal film means coating and would have suggested the provision of such on the reel body of Kazuya and of Mamoru. As more fully explained below, we agree with appellant that Manabe would not have suggested a semi-transparent coating of a metal film means on a ground film-layer.

Manabe discloses flexible lustrously metallized resinous molded articles comprised of thermoplastic resinous moldings as a substrate overlaid with a base coat,

² We presume that the examiner's reference to a "transparently" formed layer was an inadvertent error, in light of the fact that the claims call for a "semitransparently" formed layer and in light of the examiner's discussion of the term "semi-transparent" on pages 6 and 7 of the answer.

a metal film and a protective top coat, in that order, as well as a process for the manufacture of such articles (column 1, lines 11-19). A flexible polyurethane paint is used as the base coat; a metal such as copper, silver, nickel, chromium or alloys such as stainless steel and nickel-chromium are suitable for use as the metal film; and a transparent flexible polyurethane paint can be used as the protective top coat.

According to Manabe,

[t]he thickness of the metal film is generally limited within the range of 150-500 Å. If the thickness of the metal film is less than 150 Å, the coverage of the metal film is insufficient so that the substrate can be seen through the metal film. On the other hand, if the thickness exceeds 500 Å, cracks will probably be formed in the metal film when the molded article is subjected to deformation [column 6, lines 10-17].

Manabe provides no teaching or suggestion of forming the metal film on the base coat in a manner so as to permit the base coat to be seen therethrough and, in fact, teaches that the metal film coating should be sufficiently thick to prevent the substrate from being seen therethrough. We thus find no teaching or suggestion in Manabe to form a metal film layer semi-transparently on a ground film-layer as called for in appellant's claims.

The examiner's apparent reliance (answer, pages 6-7) on the encompassing of Manabe's disclosed thickness range (150-500 Å) within the broader range (50-600 Å) disclosed by appellant on page 5 of the specification to imply that Manabe's metal film, like appellant's metal film, must therefore be semitransparent overlooks that, as also

disclosed by appellant (specification, page 5), "the film thickness that will bring out a semitransparent mirroring effect will differ depending on the type of metal used as the target" and aluminum, the metal for which appellant discloses a thickness range of 50-600 Å, is not one of the metals disclosed by Manabe as suitable for the metal film layer. In fact, aluminum is described by Manabe as unsuitable because of its poor resistance to weathering and corrosion by attack of chemicals (column 5, first paragraph).

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). In light of the above, the examiner's determination, based upon the respective teachings of appellant and Manabe, that Manabe's metal film is semi-transparently formed on the base coat, is speculative at best. Accordingly, neither of the examiner's rejections, which are grounded in part on this determination, can be sustained.

CONCLUSION

To summarize, the decision of the examiner to reject claims 15-19 under 35 U.S.C. § 103 is reversed.

REVERSED



JOHN P. MCQUADE
Administrative Patent Judge

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) BOARD OF PATENT
) APPEALS
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) INTERFERENCES



JEFFREY V. NASE
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